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PATENT APPLICATION
ATTORNEY DOCKET NO. 1285

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Howard G. Page et al.

Application No.: 09/498,515

Group No.: 3622

Filed: February 4, 2000

Examiner: Yehdega Retta

For: ADVERTISING INSERTION FOR A VIDEO-ON-DEMAND SYSTEM

MAIL STOP APPEAL BRIEF - PATENTS
COMMISSIONER FOR PATENTS
P. O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

INTRODUCTION

Pursuant to the provisions of 37 CFR § 41.31 *et seq.*, Applicants hereby appeal to the Board of Patent Appeals and Interferences (the "Board") from the Examiner's final rejection dated November 8, 2005, and the subsequent Advisory Action dated February 6, 2006.

A notice of appeal is being concurrently filed, accompanied by the notice of appeal filing fee per 37 CFR § 41.20(b)(1). The brief on appeal is also accompanied by the requisite appeal brief filing fee per 37 CFR § 41.20(b)(2). A one-month extension of time is requested and authorized in the accompanying transmittal.

REAL PARTY IN INTEREST

The entire interest in the present application has been assigned to Sprint Communication Company, LP as recorded at Reel 010590, Frame 0535.

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RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 (all claims) are pending.

Claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 have been finally rejected.

Claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 are on appeal.

STATUS OF AMENDMENTS

Claims 1, 12, and 22 were amended after final rejection, and claims 3-4 and 14-15 were cancelled. The Advisory Action entered the amendments for purposes of appeal.

SUMMARY OF CLAIMED SUBJECT MATTER

This invention relates generally to a video advertising insertion system for a video-on-demand system. The invention receives a request from a viewer to view a particular selection from among available video content (see page 4, lines 19-22). In response, the selected video is transferred to the target viewer. In addition, the invention selects video advertising to insert into the video stream, with the video advertising being selected based on a viewer profile for the target viewer and the selected video content (see page 4, lines 25-27).

In some embodiments, a fast-forwarding capability is disabled when the selected video advertising is displayed (see page 5, lines 5-7).

In some embodiments, a target viewer residence is connected to a video-on-demand system according to the invention over two transport systems 202 and 204 (see FIG. 2 and page 5, lines 25-30). The video-on-demand video content is transported to the viewer over the transport system 202, while the video advertising is transported to the viewer over the transport system 204. The transport system 202 uses a faster video transfer rate than the transport system 204. Consequently, the lower-speed transport system 204 is cheaper to use than the higher-speed

transport system 202.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 are obvious under 35 U.S.C. § 103(a) over U.S. Patent 6,718,551 (Swix et al.) in view of NDS: NDS' XTV(TM) time shifting technology empowers the viewer and the broadcaster", M2 Presswire, Sept. 10, 1999, (hereinafter the XTV reference), and further in view of U.S. Patent 6,588,015 (Eyer et al.).

ARGUMENT

OUTLINE

- I. Summary of the brief on appeal.
- II. Summary of the requirements for *prima facie* obviousness.
- III. Discussion of the § 103(a) obviousness rejection of claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27.

I. Summary of the brief on appeal

- A. The 35 U.S.C. § 103(a) rejection of claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 is improper because a *prima facie* case for obviousness has not been established, as the final Office Action mischaracterizes Swix.

II. Summary of the requirements for *prima facie* obviousness.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2142. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim dependent therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

III. Discussion of the § 103(a) obviousness rejections of claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27.

Independent claims 1, 12, and 22 require transferring the selected video content to the target viewer over a first transport system and transferring the selected video advertising to the target viewer over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system.

In response to the final Office Action, Applicants amended independent claims 1, 12, and 22 in a response after final. The resulting Advisory Action admitted the claim amendments, but maintained the rejection based on the combination of Swix, the XTV reference, and Eyer.

It should be noted that the XTV reference had been previously shown by Applicants to not disclose disabling of a fast-forward capability during play of an advertisement. The final Office Action agreed that the XTV reference did not show the claimed feature. Therefore, the XTV reference should have been properly dropped from the rejection.

First, Swix does not teach or suggest first and second transport systems. The final Office Action asserts that Swix teaches two different transport systems and cites col. 13, lines 9-3 in support of this assertion. In addition, the Advisory Action asserts that “Swix . . . teaches two different communication channels (two transport systems).”

This assertion is incorrect. Instead, Swix discloses one transport system (*i.e.*, the head end 110) that utilizes one or more channels (see FIG. 1, see col. 6, lines 28-31, see col. 12, lines 63-66, and see col. 13, lines 30-41 and 50-55). In Swix, the broadcast server 105 broadcasts

video over multiple quadrature amplitude modulation (QAM) channels of the system. Clearly, Swix does not teach only a single server, only a single system, and consequently only a single source of the video. Although a single transport system can include one or more channels, two transport channels in a system do not include or in any way inform of more than one transport system.

Second, Swix does not teach or a first transport system that uses greater bandwidth for video transfer than a second transfer system. Although the Advisory Action mentions the different bandwidth capabilities recited in the present claims, interestingly, the Advisory Action does not address the bandwidth claim element. Swix does not discuss or inform of the bandwidth capacities of the channels of the broadcast server 105. Instead, Swix discloses a bandwidth savings achieved by using a single channel for delivering all video advertisements for all viewer demographic groups (see col. 13, lines 50-55). The bandwidth needed for the video-on-demand channel in Swix is therefore reduced.

Conclusion

In view of the above, applicant respectfully request that the examiner's rejection of claims 1-2, 5-8, 10-13, 16-18, 20-23, and 25-27 be reversed.

The Director is hereby authorized to charge the \$500.00 fee for filing a brief in support of an appeal and to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 210765.

Respectfully submitted,

Date: 3/7/06


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CLAIMS APPENDIX

1. A method for providing video advertising where a video-on-demand system receives a request from a target viewer for selected video content, and in response, transfers the selected video content in a video stream to the target viewer, the method comprising:

selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer;

inserting the selected video advertising into the video stream that transfers the selected video content to the target viewer;

transferring the selected video content to the target viewer over a first transport system and transferring the selected video advertising to the target viewer over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system; and

disabling fast-forward capability when the selected video advertising is displayed.

2. The method of claim 1 further comprising determining insertion points in the selected video content for the selected video advertising and inserting the selected video advertising at the insertion points.

5. The method of claim 1 further comprising selecting the selected video advertising based on a viewer profile for the target viewer.

6. The method of claim 1 wherein inserting the selected video advertising comprises using a target viewer device.

7. The method of claim 1 further comprising caching the video advertising using a target viewer device.

8. The method of claim 1 further comprising displaying the selected video content and the

selected video advertising to the target viewer.

10. The method of claim 1 further comprising re-displaying the selected video advertising after rewinding the selected video content.

11. The method of claim 1 further comprising receiving the request from the target viewer for the selected video content, and in response, transferring the selected video content in the video stream to the target viewer.

12. A video advertising insertion system where a video-on-demand system receives a request from a target viewer for selected video content, and in response, transfers the selected video content in a video stream to the target viewer, the video advertising insertion system comprising:

 a processing system configured to select video advertising that has a subject matter relation to the selected video content requested by the target viewer and to disable fast-forward capability when the selected video advertising is displayed;

 an interface configured to insert the selected video advertising into the video stream that transfers the selected video content to the target viewer;

 a first transport system configured to transfer the selected video content to the target viewer; and

 a second transport system configured to transfer the selected video advertising to the target viewer, wherein the first transport system uses greater bandwidth for video transfer than the second transport system.

13. The video advertising insertion system of claim 12 wherein the processing system is configured to determine insertion points in the selected video content for the selected video advertising and the interface is configured to insert the selected video advertising at the insertion points.

16. The video advertising insertion system of claim 12 comprising a target viewer device that

includes the interface.

17. The video advertising insertion system of claim 16 wherein the target viewer device further comprises a storage medium configured to cache the video advertising.

18. The video advertising insertion system of claim 12 further comprising a display configured to display the selected video content and the selected video advertising to the target viewer.

20. The video advertising insertion system of claim 12 wherein the processing system and the interface are configured to re-display the selected video advertising after rewinding the selected video content.

21. The video advertising insertion system of claim 12 further comprising the video-on-demand system configured to receive the request from the target viewer for the selected video content, and in response, transfer the selected video content in the video stream to the target viewer.

22. A product comprising a processor-readable storage medium storing processor-executable instructions for performing the following method for providing video advertising where a video-on-demand system receives a request from a target viewer for selected video content, and in response, transfers the selected video content in a video stream to the target viewer, the method comprising:

selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer;

directing an interface to insert the selected video advertising into the video stream that transfers the selected video content to the target viewer;

transferring the selected video content to the target viewer over a first transport system and transferring the selected video advertising to the target viewer over a second transport system, wherein the first transport system uses greater bandwidth for video transfer than the second transport system; and

disabling fast-forward capability when the selected video advertising is displayed.

23. The product of claim 22 wherein the method further comprises determining insertion points in the selected video content for the selected video advertising and directing the interface to insert the selected video advertising at the insertion points.
25. The product of claim 22 wherein the method further comprises directing the interface to re-display the selected video advertising after the selected video content is rewound.
26. The product of claim 22 wherein the method further comprises receiving and processing the request from the target viewer for the selected video content.
27. The product of claim 22 further comprising selecting the selected video advertising based on a viewer profile for the target viewer.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None